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In re Application of
Richard Levy
Serial No.: 09/357, 957
Filed: July 21, 1999
For: LUBRICANT COMPOSITIONS
AND METHODS

DECISION ON
PETITION

This is a Decision on Petitions filed under 37 C.F.R. 1.181 on October 29, 2002 and August 27, 2002. The Petitions request that the Examiner formally reopen prosecution of the application and enter the 37 C.F.R. 1.116 amendment which was filed in response to the new grounds of rejection made by the Examiner in her Examiner's Answer. Petitioner is requesting that the Examiner reopen prosecution based upon the Examiner's response to Appellants arguments concerning the 35 U.S.C. 102(b) rejection stated in the reply brief.

STATEMENT OF FACTS

- July 05, 2001. Rejections were made under 35 U.S.C. 112, 102 and 103 in the prosecution of the application. A review of the facts discloses that the Examiner in her initial office action made a rejection to claims 1, 29, 35, 41 and 42 under 35 U.S.C. 102(b) as being clearly anticipated by the Admitted Prior Art. The Examiner discusses the combination of Levy '251 with Brannon-Peppas as anticipating the claimed composition and process of making.
- September 07, 2001. The Applicant responded to the Examiner's action requesting further consideration and examination and arguing that a 35 U.S.C. 102 rejection cannot employ multiple references since a finding of anticipation requires that all aspects of the claimed invention were already described in a single reference and further if it necessary to reach beyond the boundaries of a single reference to provide missing disclosure of the claimed invention, the proper ground is not 102 but 103 obviousness.
- December 19, 2001. The Examiner in her final rejection states that the rejection to claims 29, 35 and 42 under 35 USC 102(b) is maintained for the reasons made of record in Paper

No.10, dated July 5, 2001. The rejection to claim 1 under 35 U.S.C. 102(b) was dropped in view of Applicant canceling claim 1. The Examiner never addressed Applicant's arguments in regards to the 102(b) rejection.

- March 01, 2002. Applicant filed an Appeal Brief and argues the 102(b) rejection to claims 29, 35 and 42 as not being anticipated by the admitted prior art, i.e. Levy '251 combined with Brannon-Peppas.
- May 22, 2002. The Examiner's Answer countered Appellant's arguments by asserting that one cannot show nonobviousness by attacking references individually and notes that Appellant fails to appreciate that the rejection is based on a combination of references.
- July 22, 2002. Appellant files an amendment under 37 C.F.R. 1.116 in response to the new rejection of claims 29, 35 and 42 in the Examiner's Answer of May 22, 2002. Appellant submits that the Examiner's Answer rejected the claims as obvious and as such is a new ground of rejection.
- August 8, 2002. The Examiner responded to the Appellant's arguments by issuing an advisory denying entry of the amendment because new issues would be raised and noting Appellant's argument. The application was forwarded to the Board of Appeal.
- September 3, 2002. The application was remanded to the Examiner noting that the Examiner's response to Appellant's Reply brief did not comply with MPEP 1208.03.

DECISION

M.P.E.P. 2131.01 states that normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:

- (A) Prove the primary reference contains an "enabled disclosure;"
- (B) Explain the meaning of a term used in the primary reference; or
- (C) Show that a characteristic not disclosed in the reference is inherent.

There is no evidence of record to indicate that the Examiner followed the procedures outlined in M.P.E.P. 2131.01 when making the 102(b) rejection using multiple references. Further, the Examiner in her Examiner's Answer has argued obviousness in response to Applicant's arguments concerning the 102(b) rejection.

A review of the petitioner's request and the application record indicates that the request can be granted.

The petition is **granted**.

The application is being forwarded to the Examiner for entry of the Amendment filed under 37 C.F.R. 1.116; withdrawal of the final rejection and an issuance of a new office action that addresses Applicant's amendment and clarification of whether the rejection to claims 29, 35 and 42 should be made under 35 U.S.C. 103 or 102(b).



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